REMARKS

Claims 1, 3, 5, 179-184, 186, 187, 189, 192, 193, 195, 198, 201, 204-212, 222-227, 231-233, 241, 242, 244, 245, 250, 258-263, 276, and 280-308 were pending in this application. Applicants note with appreciation that claims 3, 181-184, 187, 189, 192, 193, 195, 201, 204, 205, 207-212, 225-227, 231-233, 241, 242, 260, 261, 288-299, 303 and 305-308 have been deemed allowable. In order to expedite prosecution of the application, claims 198, 258, 259, 260, 263, 300, 301, 302, and 304 have been canceled, and claims 280-287 have been amended to correct a typographical error. Claims 1, 3, and 179-184 have also been amended to limit the claims to recite antibodies that bind to a RSV F protein, rather than antibodies that bind to a RSV antigen. The amendments are fully supported by the specification of the instant application and do not constitute new matter. Upon entry of this Amendment, claims 1, 3, 5, 179-184, 186, 187, 189, 192, 193, 195, 201, 204-212, 222-227, 231-233, 241, 242, 244, 245, 250, 261, 262, 276, 280-299, 303, and 305-308 will be pending.

Applicants also file herewith a Petition for Correction of Inventorship of the instant application under C.F.R. § 1.48(a). As requested in the accompanying Petition, Applicants request that the present application be amended to add William D. Huse, Jeffry D. Watkins, and Herren Wu as inventors. Accordingly, the inventors of the present application should be James F. Young, Scott Koenig, Leslie S. Johnson, William D. Huse, Jeffry D. Watkins and Herren Wu.

Entry of the foregoing amendments and consideration of these remarks are respectfully requested.

1. THE OBJECTIONS TO CLAIMS 281-287, 198, 250, 258, 259, 263, 300, 301, 302, AND 304 SHOULD BE WITHDRAWN

Claims 281-289 are objected to for misplacement of "or" between "182" and "183". Applicants have amended these claims, along with claim 280, to correct this typographical error. Claims 186, 222, 223, 224, 242, 244, 245, 262, and 276 are objected to for being duplicative of claims 198, 258, 259, 250, 263, 302, 304, 300, and 301. Applicants respectfully point out that claim 224 recites an antibody with the same sequence as the antibody of claim 260, rather than the antibody of claim 250. In response to this objection, Applicants have canceled claims 198, 258, 259, 260, 263, 300, 301, 302, and 304. Accordingly, Applicants respectfully assert that the objection to claims 281-287, 198, 250, 258, 259, 263, 300, 301, 302, and 304 is moot and should be withdrawn.

2. THE DOUBLE PATENTING REJECTIONS SHOULD BE WITHDRAWN

Applicants note with appreciation the Examiner's withdrawal of the obviousness-type double patenting rejection of claims 1, 5, 179, and 280-287 over claim 55 of copending U.S. application Serial No. 09/771,415 (the "'415 application"), which has issued as U.S. Patent No. 6,656,467. Applicants also acknowledge with appreciation the Examiner's withdrawal of the provisional rejection of claims 1, 180, 206, 283, and 286 under U.S.C. § 101 as claiming the same invention of claims 1, 4, 15, 36, and 73 of U.S. Application No. 09/996,228.

A. THE STATUTORY DOUBLE PATENTING REJECTION SHOULD BE WITHDRAWN

Claim 180 is provisionally rejected under 35 U.S.C. § 101 as claiming the same invention as that of claim 55 of the '415 application. The Examiner maintains that claim 180 of the present application is directed to the same invention as that of claim 55 of the '415 application. Moreover, the Examiner indicates that, in view of the difference in the inventive entity between this application and the '415 application, the issue of priority and inventorship of the alleged single invention must be resolved. For the reasons detailed below, Applicants respectfully request that this rejection be withdrawn.

In response to the issue of priority and inventorship of the '415 application and the instant application, Applicants have submitted a petition under C.F.R. § 1.48(a) to amend the inventorship in the instant application, to add William D. Huse, Jeffry D. Watkins, and Herren Wu as inventors of the instant application. Upon correction of inventorship, the inventorship of the instant application will encompass all of the inventors of the '415 application and, thus, the issues under U.S.C. §§ 102(f) and 102(g) should be resolved.

Moreover, Applicants respectfully assert that the same invention for the purpose of double patenting is not being claimed in claim 180 of the present application and claim 55 of the '415 application. An objective test for determining whether a double patenting rejection under 35 U.S.C. § 101 is appropriate is whether the claim in the application could be literally infringed without literally infringing the claim in the other application or patent. *In re Vogel*, 422 F.2d 438, 441 (CCPA 1970).

In this case, claim 180 and claim 55 do not claim identical subject matter. Both claims claim antibodies with a particular heavy chain CDR1 that bind RSV. However, the genus of antibodies claimed in claim 180 and claim 55 are not co-extensive. The only other

requirement for the antibody recited in claim 180 of the present application is that the antibody immunospecifically bind to a RSV F protein. Claim 180 does not require that the antibody be a neutralizing antibody, whereas claim 55 does. Moreover, claim 55 further requires that the antibody bind RSV with an affinity constant of at least 10^{10} M^{-1}. Accordingly, an antibody that is not neutralizing, or that binds RSV with an affinity constant of less than 10^{10} M^{-1}, could infringe claim 180 of the present application but would not infringe the antibody recited in claim 55 of the '415 application. Therefore, the same invention is not being claimed in claim 180 of the present application and claim 55 of the '415 application, and thus, the double patenting rejection under 35 U.S.C. § 101 should be withdrawn.

B. THE JUDICIALLY CREATED DOCTRINE OF OBVIOUSNESS-TYPE DOUBLE PATENTING REJECTIONS SHOULD BE WITHDRAWN

Claims 280-282 and 284-287 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 73 of U.S. Application No. 09/996,288 (the "'288 application") in view of U.S. Patent No. 5,824,307 to Johnson et al. ("Johnson"). Applicants respectfully point out to the Examiner that claim 73 of the '288 application was canceled in an amendment filed in connection with the '288 application on October 14, 2003. Therefore, Applicants respectfully assert that the rejection of claims 280-282 and 284-287 under the judicially created doctrine of obviousness-type double patenting is moot and should be withdrawn.

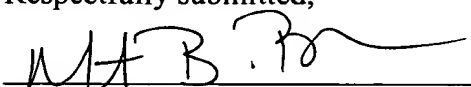
CONCLUSION

Applicants believe that the present claims meet all the requirements for patentability. Entry of the foregoing amendments and remarks into the file of the above-identified application is respectfully requested. Withdrawal of all rejections and reconsideration of the amended claims are requested. An allowance is earnestly sought.

If any issues remain, the Examiner is requested to telephone the undersigned.

Respectfully submitted,

Date: April 21, 2004



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